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Patent
Attorney Docket No. GEMS8081.081

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Zhang et al.
Serial No. : 09/681,483
Filed : April 13, 2001
For : Method and System to Request Remotely Enabled Access
to Inactive Software Options Resident on a Device
Group Art No. : 2135
Examiner : Dada, B.

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. The request is being filed with a Notice of Appeal. The review is requested for the reasons set forth hereinafter.

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REMARKS

In the rejection of claims 1-6, 8-13, 15-17, and 19-31, the Examiner has repeatedly maintained a rejection that the claimed invention was unpatentable over the combination of Hube et al. and Fenstermaker et al. The Examiner concluded that Hube et al. and Fenstermaker et al., when considered together, teach the transmission of an electronic request over a public or first communication interface and the transmission of a software key or enabler over a private or second communication interface. The Examiner's rejection ignores however that Hube et al. explicitly teaches directly away from such a bifurcated communication system.

Hube et al. teaches communication over one of a number of communication types, such as telephone lines, LANs, WANs, cellular phone channels, infrared links, and serial channels. However, regardless of the type of communication channel, Hube et al. is adamant that only one communication channel is used to make a software enablement request and enable the desired software. In fact, Hube et al. states that it is an object of its invention to provide such a "common communication interface". Specifically, Hube et al. states, "The invention relates to a system for the selective enablement of machine features and more particularly, to the selective enablement of machine features from a remote station over a common communication channel." Col. 1, ll. 6-10. Hube et al. continues, "It is still another object of the present invention to selectively change the features of machine by remote designation or feature downloading from a central control station over a common communication channel." Col. 2, ll. 59-63. The description of Fig. 2 of 5,442,541 further highlights that a single communication channel is used to make a software enablement request and enable the software.

In this regard, the reference discloses that the "remote communication system including remote host 157 [is] interconnected to Control 71 of machine 30 through a suitable channel such as telephone line 175..." Col. 10, ll. 15-21. Hube et al. further teaches that "a computer such as PC 159 with suitable input such as keyboard 180 is provided at the remote host 157 for use in establishing communication with modem 182 for transmission of data from machine 30 via line 175 to host 157 and from machine 157 to machine 30." Col. 10, ll. 44-48, emphasis added.

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That is, Hube et al. teaches a single and common communication interface so, therefore, Hube et al. either teaches communication over only a single public interface or only a single private interface, but not both.

In combination with Hube et al, the Examiner relied upon Fenstermaker et al. While Fenstermaker et al. teaches an "ultrasound method and system for enabling an ultrasound device feature," there is no teaching or suggestion that a request for feature enablement is made over one communication interface and a password or key to enable the software is transmitted over a different communication interface. Fenstermaker et al. simply teaches that "a user requests a key from a remote source" and "the key is generated by the remote source (step 420) and transmitted to the ultrasound device 100 via the key receiver 150, which can be, for example, a network link or modem (step 430)." Col. 3, ll. 29-30, 34-37. One skilled in the art, given the explicit teachings of Hube et al., would conclude that the communication disclosed by Fenstermaker et al. is via a common communication channel or interface. If a contradictory assumption could be made, then one skilled in the art would not be motivated to combine the references given that Hube et al. explicitly teaches a single and common communication channel for requesting software enablement and transmitting a key to enable the software.

Therefore, neither Hube et al. nor Fenstermaker et al. teaches or suggests separate communication interfaces for requesting feature enablement and transmitting a key to enable the feature. As such, given that claims 1, 17, and 24, each call for, in part, communication over two different communication interfaces or connections, it is believed that claims 1, 17, and 24, as well as those claims depending therefrom, to be in condition for allowance.

Claim 9 stands rejected as being unpatentable over Hube et al. in view of Fenstermaker et al. Claim 9 calls for a remote centralized facility that includes a computer programmed to receive a host ID input, wherein the host ID corresponds to a physical location of the device. The Examiner asserted that Fenstermaker et al. teaches that "the host ID corresponds to a physical location of the device (see for example, Ethernet Hardware id)." Office Action, January 3, 2005, p. 4. One skilled in the art would not recognize that an Ethernet hardware ID identifies the hardware but not the physical

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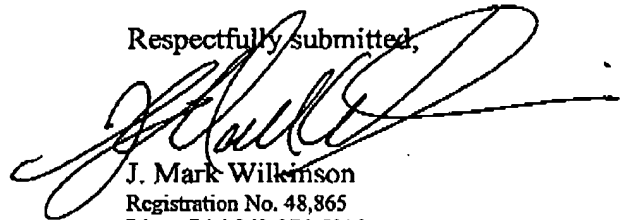
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location of the hardware. In other words, if the Ethernet hardware changes locations, the Ethernet hardware ID will not change. Thus, the Ethernet hardware ID identifies the hardware, not the hardware location.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-6, 8-13, 15-17, and 19-31.

Applicant appreciates the Examiner's consideration of these Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



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